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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,816

09/26/2007

Johannes Waldinger

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EXAMINER

NGUYEN, KIMBINH T

ART UNIT

PAPER NUMBER

2628

NOTIFICATION DATE

DELIVERY MODE

08/06/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/567,816	<b>Applicant(s)</b> WALDINGER ET AL.	
	<b>Examiner</b> Kimbinh T. Nguyen	<b>Art Unit</b> 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-16 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, in the independent claim 12, the steps of “generating”, “fixing” can be software implemented steps and are not tied to a statutory category such as a particular apparatus or device. Similarly, in the dependent claims 14-16, the steps of “fixing” are also not tied to a statutory category. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-19 recite the preamble "method" ,"apparatus" in line 1 which lack of antecedent basis for the claims.
4. Claim 13 recites the limitation "the start point and/or end point" in line 2. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 15 recites the limitation "the start point and/or end point" in line 2. There is insufficient antecedent basis for this limitation in the claim.
6. Regarding claim 12, the word "means" is preceded by the word(s) "generated", "fixed" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).
7. Regarding claim 15, the word "means" is preceded by the word(s) "effected", in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanof et al. (5,734,384).

Claim 12, Yanof et al. discloses method of representing a predeterminable region in multidimensional data sets, wherein data sets comprise in particular three-or four-dimensional image data of an object to be examined, wherein the image data are generated by means of one or more images of the object, and wherein at least one in particular two-dimensional section is made through the predeterminable region and displayed (col. 5, line 54 through col. 6, line 7; col. 6, lines 32-40), wherein the section is defined by at least one vector plane which lies in the multidimensional data set, the at least one vector plane is fixed by means of a vector, and the vector is fixed in the multidimensional data set and/or on in particular two-dimensional planes of section through the multidimensional data set (col. 7, lines 1-13), and wherein the vector is a direction vector which has a specifiable orientation and a specifiable length spanning the predeterminable region, the vector being adapted to the multidimensional data set, wherein the vector is fixed on a first two-dimensional plane of section by specifying the orientation and length, and the vector so fixed is copied on to a second plane of section,

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preferably non-parallel to the first plane of section and may be corrected thereon (col. 9, line 44 through col. 10, line 5; col. 25, lines 56-65).

Claim 13, Yanof et al. discloses the limitations in claim 12 and further discloses the at least one vector plane is fixed by the start point and/or end point of the vector and the vector is positioned orthogonally on the vector plane (col. 6, line 66 through col. 7, line 13).

Claim 14, Yanof et al. further discloses a first vector plane is fixed by the start point and a second vector plane parallel to the first vector plane is fixed by the end point of the vector and the vector is positioned orthogonally on both vector planes (col. 7, lines 1-30).

Claim 15, Yanof et al. discloses the direction of the vector is oriented from the start point to the end point, in that the section is defined by a vector plane positioned perpendicular to the vector, and the representation of the predeterminable region is effected by means of the section (S) by displacing the vector plane successively from the start point to the end point (col. 9, line 44 through col. 10, line 2).

Claim 16, Yanof et al. discloses the multidimensional data set is cut off at the vector planes by the blanking out of corresponding image data and only those image data are shown multidimensionally which lie between the vector planes (col. 14, line 17 through col. 15, line 18).

Claim 17 recites an apparatus having corresponding elements to the steps recited in the method claim 12. Therefore, the same rejection is equally valid for claim 17.

Claim 18, Yanof et al. discloses during manipulation of the vector on the first plane of section, the image of the vector is manipulated synchronously on the second plane of section .(figs. 4a and 4b).

Claim 19, Yanof et al. discloses the vector may be manipulated and copied multidimensionally in the multidimensional data set (col. 3, lines 33-64).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimbinh T. Nguyen whose telephone number is (571) 272-7644. The examiner can normally be reached on Monday to Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7761. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 2, 2009  
/Kimbinh T. Nguyen/  
Primary Examiner, Art Unit 2628

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